



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/801,167	03/07/2001	Roger Gillman	P/67-1	4310

7590 02/08/2005

Phillip M. Weiss, Esq.
Weiss & Weiss
300 Old Country Road
Suite 251
Mineola, NY 11501

EXAMINER

CHAMPAGNE, DONALD

ART UNIT	PAPER NUMBER
3622	

DATE MAILED: 02/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/801,167

Applicant(s)

GILLMAN ET AL.

Examiner

Donald L. Champagne

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed with an amendment on 3 December 2004 have been fully considered but they are not persuasive. The arguments are addressed at para. 6-7 below.

Claim Rejections - 35 USC § 102 and 35 USC § 103

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 2, 5, 7 and 8 are rejected under 35 U.S.C. 102(e) as being anticipated by Boyd.
5. Boyd teaches (independent claims 1 and 8) a method and system for providing online networking groups, the method comprising: registering three or more users by asking them to store information in *user profile database 213* (para. [0064] and [0085-0086]), which reads on entering a profile and a second profile (and a third profile) into a computer database, and creating a networking group (all three or more users/members) contained within said computer database; and a first user forming and posting an invitation to a networking meeting to two or more other users ([0049 and 0024]), the *selection preferences and criteria* including that the attendees be *intellectual property lawyers* ([0031]), the invitation being placed in *invitation database 211*, which reads on comparing said profile and

Art Unit: 3622

said second profile (comparing both user profiles to the *selection preferences and criteria*)¹, moving said second profile into a second database (*invitation database 211*) is said second profile and said second profile contain same professions and same areas of practice (*intellectual property lawyers*), and creating a network group (the invited members) contained in said second database (*invitation database 211*). Said posting an invitation to a networking meeting to two or more other users and receiving acceptances ([0044] reads on communicating online within a networking group because it is online communication among people who have expressed interest in networking together.

6. Applicant argues (first full para. on unnumbered p. 5) that “Amended claim 1 requires that the networking group network online”. That is not correct. The claims are limited to “communicating online” (claims 6 and 8) within a networking group (claim 1). As noted at the end of para. 5 above, these limitations are taught. For the benefit of applicant, the intended limitation will be interpreted.
7. Interpretation of “online networking” Unless a term is given a “clear definition” in the specification (MPEP § 2111.01), the examiner is obligated to give claims their broadest reasonable interpretation, in light of the specification, and consistent with the interpretation that those skilled in the art would reach (MPEP § 2111). An inventor may define specific terms used to describe the invention, but must do so “with reasonable clarity, deliberateness, and precision” (MPEP § 2111.01.III). A “clear definition” must establish the metes and bounds of the terms. A clear definition must unambiguously establish what is and what is not included. A clear definition is indicated by a section labeled definitions, or by the use of phrases such as “by xxx we mean”; “xxx is defined as”; or “xxx includes, ... but does not include ...”.
8. In the instant case, no such clear definition of “online networking”/“communicating online with a networking group” was found in the specification. The term is used by example in the specification, but its use meets none of the tests given in para. 6 above for a “clear definition”. The examiner is required to give the term its broadest reasonable interpretation (MPEP § 2111), which the examiner judges to be any online exchange of information among individuals, groups or institutions (Merriam-Webster Online Dictionary definition of “networking”). Hence “online networking” is also taught by the reference.

¹ Things compared to the same thing are compared to each other.

Art Unit: 3622

9. Boyd also teaches at the citations given above claim 2 (where the invitation reads on a referral). Boyd also teaches claims 5 ([0073]) and 7 ([0065-0066]).
10. Claims 3, 4 and 6 are rejected under 35 U.S.C. 103(a) as obvious over Boyd.
11. Boyd does not teach (claims 3 and 4) rewards or positive incentives commensurate with the number of invitations/referrals provided by a user. However, Boyd does teach negative incentives for a user who does not make invitations or violate invitation rules ([0053, 0073-0075 and 0111]). Because the system would work only if user make as well as honor invitations, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of Boyd rewards or positive incentives commensurate with the number of invitations/referrals provided by a user.
12. Boyd does not teach (claim 6) communicating online via video/audio conferencing. However, Boyd does teach a system with video monitors and cameras ([0094 and 0101]). Because Boyd teaches that the purpose of the reference invention is to make the best use of a user's time ([0006]), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of Boyd) meeting by video/audio conferencing.

Conclusion

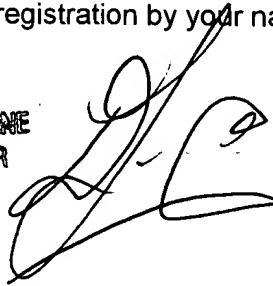
13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
14. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.
15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 6:30 AM to 5 PM ET, Monday to Thursday. The

Art Unit: 3622

examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717. The examiner's supervisor, Eric Stamber can be reached on 703-305-8469.² The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

16. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).
17. **AFTER FINAL PRACTICE** – Consistent with MPEP § 706.07(f) and 713.09, prosecution generally ends with the final rejection. Examiner will grant an interview after final only when applicant presents compelling evidence that “disposal or clarification for appeal may be accomplished with only nominal further consideration” (MPEP § 713.09). The burden is on applicant to demonstrate this requirement, preferably in no more than 25 words. Amendments are entered after final only when the amendments will clearly simplify issues, or put the case into condition for allowance, clearly and without additional search or more than nominal consideration. Applicant may have after final arguments considered and amendments entered by filing an RCE.
18. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

DONALD L. CHAMPAGNE
PRIMARY EXAMINER



Donald L. Champagne
Primary Examiner
Art Unit 3622

5 February 2005

² 571-272-6724 after the middle of April 2005.